

REMARKS

Claims 1-37 are pending in this application. By this Amendment, Applicants have amended claims 1, 16, 21 and 25. Reconsideration of the above identified application in view of the foregoing amendments and the following remarks is respectfully requested.

Finality of the Office Action:

Independent claim 21 and claims 22-24, which depend therefrom, have been rejected in the instant Office Action as being obvious over the combination of U.S. Patent No. 6,591,288 to Edwards et al. ("Edwards"), U.S. Patent No. 6,493,758 to McLain ("McLain") and U.S. Patent No. 5,740,549 to Reilly et al. ("Reilly") and the rejection has been made final because, as stated in the Office Action, "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. See MPEP 706.07(a)." MPEP 706.07(a) provides guidance on when a final rejection is proper on a second action:

MPEP 706.07(a), Final Rejection, When Proper on Second Action, provides:

"[S]econd or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

* * *

Furthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection on newly cited art ... of any claim not amended by applicant ... in spite of the fact that other claims may have been amended to require newly cited art." (Emphasis added.)

Applicant respectfully submits that the instant office action should not have been made final because the Examiner introduced a new ground of rejection that was neither necessitated by applicant's amendment nor based on information submitted in an information disclosure statement. More specifically, in the prior Office Action, claims 21-24 were rejected as being obvious over the combination of Edwards and McLain. Applicant, however, overcame that rejection without any amendment. In the present Office Action, those claims are now for the first time being rejected as being obvious over the combination of Edwards, McLain and now Reilly. Reilly was not submitted by Applicant in an information disclosure statement, but instead, was cited by the Examiner in a Form PTO-892 that accompanied the present Office Action.

In light of the foregoing, Applicant respectfully requests that the finality of the outstanding office action be withdrawn.

Rejections Under 35 U.S.C. §103(a):

Claims 1-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Edwards, McLain and Reilly. Claims 1, 16, 21 and 25 are independent.

Applicants' invention, as defined by amended claim 1, is directed to a method to enable a user of a wireless terminal to browse content, comprising: monitoring browsing activity of a user of a wireless terminal; storing content browsed by said user in a personal network cache; analyzing said browsed content to determine frequently visited content; and in response to a predetermined period of time having elapsed, periodically transmitting said frequently visited content to a terminal cache of said wireless terminal to enable said user of said wireless terminal to locally browse said frequently visited content without having to establish a network connection to browse said content. In one embodiment, the transmission of frequently visited

content to a terminal cache occurs at regular intervals that are specified in a user's profile supplied upon registration.

Edwards is directed to a data network accelerated access system. In Edwards, a user of a PC 4' with a radio transceiver 16' coupled thereto accesses a base station 14' over a wireless connection to browse the Internet 2'. The base station includes a server 26 and an associated cache 28. At the server, a record is kept for each user of the links to the Internet pages he or she most frequently visits and the associated web pages are stored in cache 28. The server also ensures that these stored pages are up to date. If a user requests a page that happens to be stored in the server's cache, the user's request is satisfied by the stored copy rather than by downloading the page from the Internet.

McLain is directed to a method and system for offline viewing of Internet content with a mobile device. In one embodiment, a host computer 16, such as a desk top, downloads the content from the Internet 14 and then transfers it via synchronization modules (24, 26) to a mobile device 18 for storage in its cache 28. A user of the device may then browse the content while offline. In an alternate embodiment, the mobile device directly downloads the content for offline browsing.

Reilly is directed to an information and advertising distribution system and method wherein a subscriber's computer initiates connections to an information server to receive both administrative updates and news story updates to its information database 184. The subscriber computer initiates the connection to receive updates in accordance with a connection schedule 215, which may be either a default schedule (e.g., a randomly selected time between 11 p.m and 7 a.m local time) or something other than the default schedule (e.g., during the subscriber's typical lunch time).

Neither Edwards, McLain nor Reilly, however, teach or suggest “a personal network cache” for each user, as required by claim 1. Rather, in Edwards (the reference relied upon by the Examiner for this feature), although a record is kept at the server 26 for each user of the Internet pages he or she most frequently visits, a user’s favorite pages are stored in cache 28, which is a group cache, rather than a personal network cache. See, e.g., Edwards, col. 7, lines 33-38, wherein a favorite page can already be stored in cache 28 because it is the favorite page of another user and no additional request for the page to be downloaded from the Internet need be made. Thus, cache 28 of Edwards is clearly a group cache, rather than a personal network cache, as required by claim 1.

Additionally, neither Edwards, McLain nor Reilly teach or suggest “in response to a predetermined period of time having elapsed,” periodically transmitting said frequently visited content to a terminal cache of said wireless terminal, as further required by claim 1. Instead, in Reilly (the reference relied upon by the Examiner for “periodically transmitting”), unlike in the present invention, a subscriber terminal initiates each and every connection to the information server whenever its connection schedule dictates that a connection should be made to receive an update. Reilly, unlike the present invention, thus burdens the network with unnecessary traffic by requiring the subscriber’s computer to initiate the update. The transmission of updates in Reilly from the information server to a subscriber unit is therefore in response to a subscriber unit’s request, rather than in response to a predetermined period of time having elapsed. Moreover, although Reilly mentions an alternate embodiment in passing wherein the information server broadcasts information updates to all computers of registered subscribers (16/55-60), Reilly does not disclose that the updates are broadcast “in response to a predetermined period of time having elapsed”.

Accordingly, Applicants respectfully submit that claim 1 is neither anticipated by, nor rendered obvious over, Edwards, McLain and Reilly.

Claims 16, 21 and 25, as amended, contain limitations similar to those found in amended claim 1, and thus, are allowable for at least the same reasons.

Dependent Claims:

With respect to at least dependent claims 5, 7, 28, 35 and 36, the Examiner has admitted that none of the cited prior art discloses the features added by these claims. Nevertheless, the Examiner has taken the position that these features would have been obvious without providing any evidence of (1) the knowledge of one of ordinary skill in the art concerning these features at the time the invention was made and (2) the stated motivation to incorporate these features into the cited references. Applicants respectfully submit that these features would not have been obvious and, that the Examiner's statements to the contrary are unsupported and, are thus, improper.

Also, with respect to dependent claim 4, Applicants respectfully submit that Edwards neither teaches nor suggests that “related content is extracted from personal network caches of other wireless terminal users having similar interests to said user of said wireless terminal.” First, for the reasons discussed above, Edwards does not disclose a personal network cache. Second, in Edwards, at col. 6, lines 49-57 (the passage relied upon by the Examiner in rejecting claim 4), a user request for a page that happens to be in the cache because it is frequently used by a plurality of users, is satisfied by the cached copy rather than by downloading it from the network. Thus, the cited passage of Edwards does not disclose extracting “related content”, let alone doing so from caches of other wireless terminal users

having similar interests. Instead, Edwards merely discloses obtaining the particular page that the user has requested.

Applicants do not believe it necessary at this time to further address the rejections of the dependent claims as Applicants believe that the foregoing arguments and amendments place the independent claims in condition for allowance. Applicants, however, reserve the right to address those rejections in the future should such a response be deemed necessary and appropriate.

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance, and an early and favorable examination on the merits is respectfully requested.

AUTHORIZATION

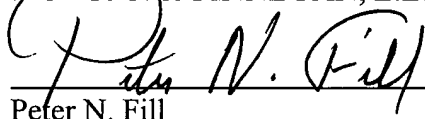
The Commissioner is hereby authorized to charge any additional fees which may be required by this response, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4208-4023. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 4208-4023. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

Respectfully submitted,
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Dated: May 10, 2004

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